

- 62 c) determining the presence or absence of said target analyte.

### REMARKS

Claims 18-36 are pending. Claim 19 and 36 are amended herein to include proper antecedent basis as suggested by the Examiner. A Clean version of the pending claims is appended hereto as Appendix A. A Version Showing Changes is appended hereto as Appendix B.

#### Rejection under 35 U.S.C. § 112, first paragraph

Claims 20, 33 and 34 remain rejected under 35 U.S.C. § 112, first paragraph, for lack of written description. The Examiner notes that the claims recite that each assay location comprises a "library" of bioactive agents and that while the specification discloses a library of bioactive agents, the specification does not disclose that each assay location comprises a library of bioactive agents. The Examiner indicates that Applicants may overcome this rejection by pointing out where support can be found in the specification for each assay location comprising a library of bioactive agents. Applicants respectfully traverse.

Initially Applicants respectfully draw the Examiner's attention to the Response to Office Action mailed April 16, 2002 (in response to the Office Action of October 19, 2001. In this response, Applicants traversed the rejection of claims 20, 33 and 34 under 35 U.S.C. § 112, first paragraph, for lack of written description. Applicants noted that:

The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement. MPEP 2163.02. Rather, the test for sufficiency of support in a parent application is whether the disclosure of the application relied upon "reasonably conveys to the artisan that the inventor had possession at that time of the later claimed subject matter." *Ralston Purina Co. v. Far-Mar-Co., Inc.*, 772 F.2d 1570, 1575, 227 USPQ 177, 179 (Fed Cir. 1985) (quoting *In re Kaslow*, 707 F.2d 1366, 1375, 217 USPQ 1089, 1096 (Fed. Cir. 1983)).

The present invention provides a bead in each well (e.g. page 24, line 4); the beads have a bioactive agent (e.g. summary of the invention, page 2, lines 30-33 and page 4, lines 27-30); the bioactive agent can come from a library (e.g. page 12, lines 30-35). In a preferred embodiment a library is used (e.g. page 13, lines 13-16). Applicants submit that the specification would convey to one

of skill in the art that applicants were in possession of the subject matter of claim 20, 33, and 34.

In response, as noted in the advisory action (paper no. 17), the Examiner noted that the Applicant's reply has overcome the rejection of claims 20, 33 and 34 under 35 U.S.C. § 112, first paragraph. It thus appeared that this rejection was overcome. As such, Applicants did not traverse or further address this rejection. Indeed, while the Examiner indicates in the present Office Action, that this rejection is "maintained", Applicants note that they previously have traversed and overcome this rejection. As such, Applicants respectfully request the Examiner to withdraw the rejection.

**Rejection under 35 U.S.C. § 112, second paragraph**

Claims 18-36 are rejected under 35 U.S.C. § 112, second paragraph as being indefinite. Applicants respectfully traverse.

Claims 18-35 are rejected because it is not clear if an assay location is an array location. The Examiner requests clarification.

In response, Applicants note that the claims recite "a substrate with a surface comprising a plurality of assay locations, each assay location comprising an array location comprising a plurality of discrete sites". Thus, the assay locations each comprise an array location. Applicants draw the Examiner's attention to p. 7, lines 36-37, where it is noted that the assay location is the location where the assay will occur. An assay location is exemplified by, but not limited to, a well of a microtiter plate (see p. 4, line 14). Moreover, as noted at p. 4, line 13-14, an array is present within each well of a microtiter plate. The array location comprises discrete sites. Thus, when the substrate comprises assay locations, wherein each assay location comprises discrete sites, the portion of the assay location that has the discrete sites is the array location.

In addition, the Examiner notes that claims 18-34 recite "array" while claims 35 and 36 recite "composite array". The Examiner requests clarification as to the difference between these two terms.

Applicants note that claims 18-34 describe a substrate with a surface comprising a plurality of assay locations. The claims further describe array locations. Thus, in claims 18-34, where reference is made to array, the claims are describing the components of each array location. Claims 35-36 include the term "a composite array comprising a plurality of assay

locations". As set forth at p. 7, lines 2-5, a composite array includes "a plurality of individual arrays". Thus, claims 35-36 are describing a plurality of individual arrays when reference is made to composite array; claims 18-34 are describing the elements of individual arrays, when reference is made to array.

Claims 19 and 36 are rejected for lack of antecedent basis for the term "said sample".

In response, Applicants have amended the claims to include proper antecedent basis.

In addition, the Examiner indicates that it is not clear in claim 19 if microspheres are distributed at one array location as one microsphere per discrete site and not distributed at any other array location or if microspheres are distributed at one array location as one microsphere per discrete site and as more than one microsphere per discrete site at other array locations. Applicants respectfully traverse.

In response, Applicants note that the claims set forth that there are a plurality of array locations with discrete sites and a population of microspheres distributed on at least one of said array locations such that said discrete sites each contain no more than one microsphere. Applicants submit that this clearly defines the invention. Applicants also submit that the claim makes no assertion about the nature of the array locations other than the one on which beads are distributed. As noted at p. 4, lines 20-35, arrays are not limited to beads. That is, arrays can include beads distributed on the surface, or other types of arrays can be used, such as, but not limited to spotted, printed or photolithographic arrays. Accordingly, Applicants submit that the claim clearly defines the invention.

In light of the clarifications and amendments submitted herein Applicants submit that the claims clearly define the inventions. Accordingly, Applicants respectfully request the Examiner to withdraw the rejection.

#### **Allowable subject matter**

The Examiner indicated that claims 18 and 19 would be allowable if rewritten or amended to overcome the rejections under 35 U.S.C. § 112, second paragraph. Applicants believe that in light of the clarifications and amendments, that the rejection of claims 18 and 19 have been overcome. Claim 19 was amended. It was not clear what amendment of claim 18 was desired. Thus, instead of amending claim 18, Applicants have attempted to clarify the claims. Accordingly, Applicants submit that the claims should be in form for allowance.


**CONCLUSION**

Applicants submit that the claims are now in condition for allowance and an early notification of such is solicited. Please direct any calls in connection with this application to the undersigned at (415) 781-1989.

Respectfully submitted,

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Date: 2/18/2003

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